



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,183	10/05/2001	Akihiko Toyoshima	50P4257.05	3119

36738 7590 04/23/2004

ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101

EXAMINER

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,183

Applicant(s)

TOYOSHIMA, AKIHIKO

Examiner

Marcos L Torres

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-17 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 3-30-2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: input device, such as keypad or keyboard, and an output device, such as a visual display.

Applicant is required to cancel the new matter in the reply to this Office Action.

Election/Restrictions

2. This amendment contains claims 18-22 drawn to an invention nonelected. The applicant is reminded that nonelected groups are withdrawn from consideration and should be canceled or nonelected claims (37 CFR 1.142 b).

Response to Arguments

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are part of the new matter, since the new matter is required to be canceled (i.e., visual display, input device), the features are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 11-12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Helle.

As to claims 1-2 and 14, Helle discloses a method for providing security to a wireless module, said method comprising securing data to the wireless module and providing a security code to the wireless module after the wireless module has been activated (see col. 1, lines 9-35).

As to claims 11 and 12, Helle discloses notifying to the user of the peripheral device of said security code and requiring an input of the security code (see col. 3, lines 5-7).

As to claims 13 and 16, Helle discloses a security system for a wireless module comprising a wireless module configured to receive security data and a peripheral device in communication with said wireless module and configured to receive security data and transmit peripheral data (see col. 1, lines 9-35; col. 3, line 63 – col. 4, line 2; col. 1, lines 15-16).

Art Unit: 2683

6. Claims 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Findikli.

As to claims 23-24 and 25, Findikli discloses a wireless module comprising an electronic serial number, said wireless module configured to be in electronic communication with at least one peripheral device, said wireless module further configured to store said electronic serial number (see col. 4, lines 17-25).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helle in view of Borgelt.

As to claim 3, Helle discloses issuing a security code through wireless transmission to the wireless module (see col. 3, lines 46-55). Helle does not specifically disclose encrypting/decrypting security codes. Borgelt disclose encrypting/decrypting

security codes (see col. 2, lines 23-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Helle method for the simple purpose of enhanced security.

As to claims 4-6 and 7, Helle discloses storing a security code in a wireless module (see col. 3, line 63 – col. 4, line 2) and peripheral device (see col. 1, lines 15-16).

10. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Helle in view of Borgelt as applied to claims 3-7 above, and further in view of Findikli.

As to claim 8 and 15, Helle discloses everything claimed as explained above except for providing to the wireless module with an electronic serial number and storing said electronic serial number to said peripheral device. Findikli discloses providing to the wireless module with an electronic serial number and storing said electronic serial number to said peripheral device (see col. 4, lines 17-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for security and tracking purposes.

As to claims 9 and 10, Helle discloses providing to a peripheral device data and storing said data to the wireless module (see col. 3, line 63 - col. 4 line 2).

As to claim 17, Helle discloses storing in peripheral device security code (see col. 1, lines 9-35). Helle does not specifically disclose providing to the wireless module with an electronic serial number. Findikli discloses providing to the wireless module with an electronic serial number and storing said electronic serial number to said peripheral device (see col. 4, lines 17-25). Therefore, it would have been obvious to one of the

Art Unit: 2683

ordinary skill in the art at the time of the invention to add this technique for security and tracking purposes.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this Office Action should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 703-872-9306

For formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres
Examiner
Art Unit 2683

Mlt



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600